

Gray

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/070,039	
	Filing Date	October 22, 2002	
	First Named Inventor	Alonso- Alija, et al.	
	Art Unit	1624	
	Examiner Name	Kifle, Bruck	
Total Number of Pages in This Submission	5	Attorney Docket Number	Le A 33 893

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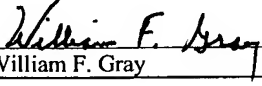
Appl. No.: 10/070,039 Confirmation No. 9715
Applicant(s): Alonso-Alija, et al.
Filed: 10/22/2002
TC/A.U.: 1624
Examiner: Kifle, Bruck

Docket No.: Le A 33 893
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William F. Gray

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

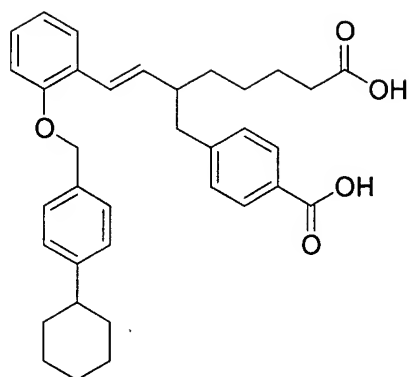
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Sir:

This is in response to the Office Action dated 10/07/2004. In response to the requirement for election of a single species, applicants elect the species of example 72 (page 168) to begin the prosecution in this application. The structure of example 72 is as follows:



Claims 1-4, 6-9, and 12-20 are deemed to read on the elected species.

Unity of Invention

The examiner states that the claims lack unity of invention because the compounds claimed do not possess a single structural element that is shared by all of the alternatives. He further states that the common structural feature should be a patentable advance over the prior art. This statement is deemed to reflect an imperfect understanding of the unity of invention rules, as explained below. In addition, the examiner recites the definition of “special technical feature” and states that if the feature is known, it is not “special”. This is deemed to be an inaccurate statement, as the rule makes clear that it is the contribution which each claimed invention, considered as a whole, makes over the prior art which is important, and that it is the “special technical feature” which defines what that contribution to the claimed inventions is. The meaning of “special technical feature” is discussed below in the context of the rules on unity of invention. The special technical feature(s) requirement in a Markush claim is met when the alternatives are of a similar nature, and this requirement can in turn be met by a combination of a common property or activity and one or more shared significant structural features.

The examiner’s determination of lack of unity of invention is deemed to be premature, as it does not appear that he has analyzed the examples to determine whether they contain common structural features, and if so, what these are and why they do not satisfy the unity of invention requirements.

An international application must relate to one invention only, or, if there is more than one invention, those inventions must be linked so as to form a single general inventive concept

(Rule 13.1). Inventions are considered linked so as to form a single general inventive concept only when there is a technical relationship involving one or more of the same or corresponding special technical features. The expression “special technical features” means those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art (Rule 13.2).

Annex B of the PCT Administrative Instructions explains the method for determining unity of invention contained in Rule 13.2 in greater detail with respect to three particular situations: (i) combinations of different categories of claims, (ii) Markush practice, and (iii) intermediate and final products (Annex B, Part 1(d)).

Markush practice under Rule 13.2 is dealt with in the PCT Administrative Instructions, Annex B, Part 1(f). In “Markush practice”, a single claim defines alternatives, chemical or non-chemical. The requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2 are considered to be met when the alternatives are of a similar nature.

According to Annex B, Part 1(f)(i), when the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

- (A) all alternatives have a common property or activity, and
- (B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or
- (B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

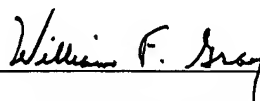
Annex B, Part 1(f)(ii): In paragraph (f)(i)(B)(1), above, the words “significant structural element is shared by all of the alternatives” refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure

constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

Annex B, Part 1(f)(iii): In paragraph (f)(i)(B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

Appendix B, part 2, provides examples concerning unity of invention. Part I relates to claims in different categories. Part II relates to claims in the same category. Part III relates to Markush practice. The examples provided in part III (Markush practice) show that the common structure shared by all of the alternatives does not need to be a patentable advance over the art, so long as it occupies a large portion of the structures of the alternatives, in accordance with Annex B, part 1(f)(ii). As indicated in Annex B, part 1(f)(ii), it is only in case the compounds have in common only a small portion of their structures that the commonly shared structure should constitute a structurally distinctive portion in view of the existing prior art. Note, moreover, that the foregoing language does not state that the common structural feature must be a patentable advance over the prior art. It may possibly mean only that the commonly shared structure should be "distinctive" in the sense that this structural feature has not previously been employed in the context of similar compounds of the prior art.

Respectfully submitted,



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